

## **REMARKS**

This application has been reviewed in light of the Office Action mailed May 1, 2006. Reconsideration of this application in view of the below remarks is respectfully requested. Claims 3 – 5, 8 – 14, 17 – 26 and 28 - 32 are pending in the application with Claims 21 and 27 being in independent form. By the present amendment, Claims 3, 8, 9, 12, 13, 17, 18, 21, 25 – 28, 30 and 31 are amended and Claims 10 and 19 are canceled. No new subject matter is introduced into the disclosure by way of the present amendment.

### **I. Objection to Claim 27**

Claim 27 is objected to for informalities. Namely, the Examiner avers that the word “disable” recited in line 20 of Claim 27 should be “disables”. In response, Claim 27 has been amended to correct this grammatical error as suggested by the Examiner. Accordingly, Applicant respectfully request withdrawal of the objection to Claim 27.

### **II. Rejection of Claims 12 – 14, 17 – 20 and 30 – 31 Under 35 U.S.C. § 112, Second Paragraph**

Claims 12 – 14, 17 – 20 and 30 – 31 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter Applicant regards as the invention. Specifically, the Examiner alleges that the limitation of “the energy transmission cable” recited in Claim 12, line 7 lacks sufficient antecedent basis in the claim.

However, the limitation has been removed from Claim 12 by way of the present amendment. Therefore, the rejection to Claims 12 – 14, 17 – 20 and 30 – 31 under 35 U.S.C. § 112, second paragraph are moot. Accordingly, Applicant respectfully request withdrawal of the rejection with respect to Claims 12 – 14, 17 – 20 and 30 – 31 under 35 U.S.C. § 112, second paragraph.

### **III. Rejection of Claims 3 – 5, 8, 9, 11– 14, 17, 18, 20 – 22 and 24 – 32 Under 35 U.S.C. § 103(a)**

Claims 3, 4, 21 – 26, 28, 29 and 32 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 5,400,267 issued to Denen et al. in view of U.S. Patent No. 4,038,625 issued to Tompkins et al. It appears that Claim 27 has inadvertently been omitted but intended by the Examiner to be included under the present rejection. While the rejection of Claim 27 is improper due to this omission, in the interest of advancing prosecution, Applicant will address the present rejection with regards to Claim 27 as well.

In light of the present rejection, Claims 21 and 27 have been amended to recite limitations directed to the feature of converting electrical energy generated by a drive device unit into light energy, which is received by a second connector without mechanical contact and converted by the second connector into electrical energy.

As conceded by the Examiner, the Denen reference fails to disclose or suggest energy being received at a second connector without mechanical contact. To overcome this deficiency in the Denen reference, the Examiner has cited Tompkins as disclosing transmitting energy between connectors without mechanical contact.

Tompkins discloses an inductive coupling for transferring energy. However, Tompkins fails to disclose or suggest converting electrical energy into light energy prior to receipt without mechanical contact by a second connector, whereupon the light energy is then converted into electrical energy, as recited in claims 21 and 27. Therefore, claims 21 and 27 are allowable over the cited prior art references.

Additionally, as Claims 3, 4, 22 – 26, 28, 29 and 32 depend from independent Claims 21 and 27, these claims include all the limitations recited therein by those independent claims.

Therefore, for at least the reasons given above, Claims 3, 4, 22-26, 28, 29 and 32 are believed to be patentably distinct and allowable over the cited prior art references.

Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claims 3, 4, 21 – 29 and 32 under 35 U.S.C. § 103(a) over Denen et al. in view of Tompkins et al.

The Examiner has indicated that Claims 25 and 26 do not recite additional method steps. In response, Claim 25 has been amended to clearly point out the further step of selecting the surgical instrument from a plurality of surgical instruments; and Claim 26 has been amended to depend from Claim 25.

Regarding the remaining claims, Claim 5 is rejected under 35 U.S.C. § 103(a) as allegedly obvious over Denen et al. in view of Tompkins et al. and further in view of U.S. Patent No. 5,401,175 issued to Guimond et al.; Claims 8 – 11 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Denen et al. in view of Tompkins et al. and further in view of U.S. Patent No. 6,068,627 issued to Orszulak et al.; Claims 12 – 13, 17 – 20 and 30 – 31 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Denen et al. in view of Tompkins et al. and further in view of U.S. Publication No. 2002/0111621 issued to Wallace et al. and Orszulak et al.; and Claim 14 is rejected under 35 U.S.C. § 103(a) as allegedly obvious over Denen et al. in view of Tompkins et al., further in view of Wallace et al. and Orszulak et al., and still further in view of Guimond et al.

In response, Claims 10 and 19 have been canceled, thus rendering the rejection moot with respect to these claims.

Addressing the above-cited § 103(a) rejections with respect to Claims 5, 8 – 9, 11, 12 – 14, 17, 18, 20 and 30 – 31, Tompkins, Orszulak and Wallace fail to overcome the deficiencies in

Denen as identified above with respect to Claims 21 and 27. Specifically, Denen, Tompkins, Orszulak and Wallace, taken alone or in any proper combination, fail to disclose or suggest converting electrical energy into light energy, and a second connector receiving light energy without mechanical contact and converting the received light energy into electrical energy, as recited in the independent claims.


Therefore, for at least the reasons given above, Claims 5, 8 – 9, 11, 12 – 14, 17, 18, 20 and 30 – 31 are believed to be patentably distinct and allowable over the cited prior art references. Accordingly, Applicant respectfully requests withdrawal of the rejections with respect to Claims 5, 8 – 9, 11, 12 – 14, 17, 18, 20 and 30 – 31 under 35 U.S.C. § 103(a) over Denen, Tompkins, Orszulak and Wallace.

## CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 3 – 5, 8, 9, 11– 14, 17, 18, 20 – 22 and 24 - 32 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,



Paul J. Esatto, Jr.  
Registration No. 30,749

SCULLY, SCOTT, MURPHY & PRESSER, P.C.  
400 Garden City Plaza - Ste. 300  
Garden City, New York 11530  
(516) 742-4343  
PJE:DAT:jam